REMARKS

I. Introduction

Applicants gratefully acknowledge the courtesy extended by Examiner Jones to their undersigned attorney during the telephonic interview on March 21, 2008. During the interview, Applicants proposed and the Examiner agreed to enter certain amendments that would clarify recited Formula I as a compound that must contain a radiolabel. *See* Interview Summary dated March 25, 2008. In view of the amendments, Applicants also take this opportunity to respond to the PTO's Advisory Action mailed on January 14, 2008.

II. Status of the Claims

Claim 1 is amended to delete "hydrogen" from the definition of substituent R^4. Accordingly, dependent claims 4, 6, 7, and 9 are amended to reflect the revision to R^4. No claims are cancelled. Thus, after entry of the foregoing amendments, claims 1-27 will be pending.

III. The Advisory Action

In the Advisory Action the PTO maintained its rejection of claim 1 over patented claim 4 of U.S. Patent No. 7,270,800 on grounds of obviousness-type double patenting. Responsive to Applicants' reply filed on December 18, 2007, the PTO called attention to a number of species recited in the patented claim that feature a halo substituent corresponding to present variable R^2, *e.g.*, compound Nos. 2, 4, 6, and 8, among others. Because cited claim 4 prescribes the formal replacement of at least one atom in each of the recited species with a radiohalogen, the PTO concluded that it would be obvious to perform such a replacement at R^2, thereby yielding a compound conforming to present formula I. In reaching this conclusion, the PTO would appear to ascribe to person of ordinary skill a knowledge of present claim 1, *viz.* "the skilled artisan would recognize that . . . the instant invention discloses a radiohalogen at position R^2." Cited claim 4, however, does not support the PTO's reasoning, and so Applicants respectfully traverse the rejection.

As a threshold matter, the PTO's analysis impermissibly relies upon a hindsight knowledge of Applicants' claim 1. By this flawed approach, the PTO would have the skilled artisan refine a selection of radiohalogens and substitution patterns in cited claim 4, such selection being unprincipled but for the specific requirements of present formula I, *i.e.*, R^2 must be non-radioactive or radioactive halo substituent.

Under the correct rule of law, by contrast, the skilled person is not imbued with such hindsight knowledge. Thus, the issue here is whether a compound bearing radiohalo substitution at R^2 is an obvious choice in view of the compounds, depicted in cited claim 4, that do not qualify the position where a radiohalo substituent is to reside.

Applicants' last response emphasized in this context that claim 4 calls no more attention to the position corresponding to present variable R^2 than any other available point of substitution in the recited compounds. This is true even though a number of species cited by the PTO feature non-radioactive halo substituents at R^2. There is no case law holding that isotopes of an element are *prima facie* obvious over each other. To illustrate, the skilled artisan would not have considered it obvious to replace F by ^{18}F any more than he would have replaced H by ^{18}F.

The compounds in patented claim 4 feature many positions where a radiohalo substituent *could* reside. Pursuant to the considerations detailed above, there is nothing in claim 4 that, in context, would have suggested position or positions where a radiohalo substituent could be present. Thus, the skilled artisan would not have considered obvious that small fraction of compounds wherein R^2 is a radiohalo substituent, as presently recited. For at least these reasons, claim 1 does not give rise to any double patenting concern.

Applicants submit that the present application is in condition for allowance. Examiner Jones is invited to contact the undersigned directly, should she feel that any issue warrants further consideration.

Respectfully submitted,

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By 

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.